PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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ROLAND K. BOWLER II

In re application of	)	
	)	Atty. Docket No. 8313
MISZCZAK ET AL.	)	
	)	Examiner M. Elve
Appl. No. 09/227,242	)	
	)	Art Unit 1725
Filed 8 January 1999	)	

For: "Ultra Low Carbon Metal-Core Weld Wire"

RESPONSE UNDER 37 CFR 1.111

Assistant Commissioner for Patents
Washington D.C. 20231

SIR:

MISZCZAK ET AL.
"Ultra Low Carbon Metal-Core Weld Wire"
Atty Docket No. 8313

Response Under 37 CFR 1.111
Appl. No. 09/227,242
Examiner Elve, Art Unit 1725

The following is enclosed in response to the non-final Official Action of 14 January 2003:

[X] Response under 37 CFR 1.111 (6 pages).

AUTHORIZATION TO DEBIT DEPOSIT ACCOUNT

The Commissioner for Patents & Trademarks is hereby authorized to debit any additional fees required under 37 C.F.R. 1.16 and 1.17 from, and to credit any excess fees paid herewith to, Deposit Account No. 02-3290 of the undersigned in connection with the papers presented herewith.

Respectfully submitted,

ROLAND K. BOWLER II 20 FEB. 2003
REG. No. 33,477

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SIR

Request for Consideration

The non-final Official Action of 14 January 2003, in which the Examiner has withdrawn the rejection of the claims under 35 U.S.C. §102, has been considered carefully.

Reconsideration of the application in view of the remarks below is respectfully requested.

Response To Rejection Under 35 USC 112, 2nd paragraph

The Examiner has reasserted the rejection of Claims 9-10, 12-13, 16, 23-24 and 26-27 under 35 U.S.C. 112, second paragraph, by re-alleging that it is unknown whether the "... combinations of Fe-Mn Fe-Si, Fe-Ti and Fe-Mn-Si ... are merely combined or compounds."

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In the Official Action of 14 January 2003, the Examiner has not responded to applicants arguments in the Supplemental Appeal Brief of 19 November 2002 that the limitations in the claims at issue are drawn to compounds (rather than elements as interpreted by the Examiner) and that the claims are therefore not indefinite under 35 U.S.C. § 112, second para. The discussion is set forth more fully in the Supplemental Appeal Brief filed on 19 November 2002 responsive to the Official action of 3 October 2002, rejecting Claims 9-10, 12-13, 16, 23-24 and 26-27 under 35 U.S.C. 112, second paragraph on the same grounds asserted in the Official action of 14 January 2003.

The argument in Supplemental Appeal Brief filed on 19 November 2003 responsive to the Official action of 3 October 2002 is hereby maintained and reasserted in response to the rejection of Claims 9-10, 12-13, 16, 23-24 and 26-27 under 35 U.S.C. § 112, 2nd paragraph on the same grounds in the Official Action of 14 January 2003.

The Applicants respectfully request that Claims 9-10, 12-13, 16, 23-24 and 26-27 be allowed in light of the discussion above and the assertions made in the Supplemental Appeal Brief filed on 19 November 2002. Alternatively, the Applicants hereby demand that the Examiner reinstate the appeal as requested in the Reinstatement of Appeal filed on 19 November 2002 and answer the Supplemental Appeal Brief also filed on 19 November 2002 without further delay.

Response to Rejection Under 35 U.S.C. §103

The Examiner maintains the rejection of Claims 1, 3, 5, 9-10, 12-13 and 16

under 35 U.S.C. § 103 for obviousness under 35 USC 103, in view of U.S. Patent No. 5,824,992 (Nagarajan). The referenced rejection under 35 U.S.C. § 103 is based upon grounds stated previously in the Official Action of 3 October 2002.

Discussion of Examiner's Refusal to Consider Secondary Considerations

In the rejection of Claims 1, 3, 5, 9-10, 12-13 and 16 under 35 U.S.C. § 103 for obviousness, the Examiner has failed to address Applicants arguments addressing the rejection of the claims for obviousness, including the arguments supporting the patentability of the claims at issue in Applicants Supplemental Appeal Brief filed on 19 November 2002. Particularly, the Examiner's rejection relies upon a line jurisprudential authority, including *Titanium Metals v. Banner*, 227 USPQ 773, that supports the establishment of a prima facie case of obviousness under 35 U.S.C. § 103 where a claimed range is near or overlapping a prior art range.

The Examiner has failed however to address or even acknowledge Applicants submission and discussion of secondary considerations, which are supported by affidavits of record, rebutting the prima facie rejection of the claims for obviousness under 35 U.S.C. § 103.

The framework for making obviousness/non-obviousness determinations under 35 U.S.C. § 103 established by the United States Supreme Court in the landmark case of *Graham v. John Deere* compels the Examiner to give due consideration to secondary considerations, otherwise known as objective indicia of non-obviousness, when making obviousness/non-obviousness determinations under 35 U.S.C. § 103. *Graham v.*

John Deere, Co., 383 U.S. 1, 148 USPQ 459 (1966). The Commissioner has fully adopted the framework for making obvious/non-obviousness determinations under 35 U.S.C. §103 established in *Graham v. John Deere.* See MPEP § 2141.

Discussion of Preponderance Standard

The ultimate determination of patentability is measured by the preponderance standard of proof and must be based upon consideration of the entire record, with due consideration to the persuasiveness of any arguments and secondary considerations submitted in rebuttal to a prima facie case of obviousness. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992).

The argument in Supplemental Appeal Brief filed on 19 November 2003 responsive to the Official action of 3 October 2002 addressing the rejection of the Claims under 35 U.S.C. § 103 is hereby maintained and reasserted, including applicants' reliance on secondary considerations and the supporting affidavits of record.

Kindly re-consider claimed inventions in view of the discussion above giving due consideration to the persuasiveness of applicants arguments in the Supplemental Appeal Brief of 19 November 2002 that the claimed inventions are non-obvious and the secondary consideration information submitted in rebuttal to the prima facie case of obviousness based upon Nagarajan.

The Applicants respectfully request that Claims 1, 3, 5, 9-10, 12-13 and 16 be allowed in light of the assertions made in the Supplemental Appeal Brief filed on 19 November 2002. Alternatively, the Applicants hereby demand that the Examiner reinstate

the appeal as requested on 19 November 2002 and answer the Supplemental Appeal Brief also filed on 19 November 2002 without further delay.

Request for Reinstatement of Appeal

The Applicants hereby demand that the Examiner reinstate the appeal as requested in the Reinstatement of Appeal of 19 November 2002 and answer the Supplemental Appeal Brief also filed on 19 November 2002 without further delay if all pending Claims are not allowed in view of the discussion above.

The instant response incorporating the arguments of the Supplemental Appeal Brief and the request for Reinstatement of the Appeal filed on 19 November 2002 is fully responsive to the Official Action of 14 January 2003.

In view of the discussion above, it is submitted that all pending claims of the present application are now in condition for allowance. Kindly withdraw any rejections and objections thereto and allow the claims of the present application to issue as a United States Patent.

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In view of the discussion above, it is submitted that all pending claims of the present application are now in condition for allowance. Kindly withdraw any rejections and objections thereto and allow the claims of the present application to issue as a United States Patent.

Respectfully submitted,

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